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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/006,638

11/08/2001

Travis J. Parry

10008082-1

1867

7590

05/25/2004

HEWLETT-PACKARD COMPANY  
Intellectual Property Administration  
P.O. Box 272400  
Fort Collins, CO 80527-2400

EXAMINER

WALLERSON, MARK E

ART UNIT

PAPER NUMBER

2626

DATE MAILED: 05/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/006,638

Applicant(s)

PARRY, TRAVIS J.

Examiner

Mark E. Wallerson

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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**Part III DETAILED ACTION**

*Notice to Applicant(s)*

1. This action is responsive to the following communications: amendment filed on 3/22/2004.

2. This application has been reconsidered. Claims 1-22 are pending.

*Information Disclosure Statement*

3. The references listed in the Information Disclosure Statement dated 3/22/2004 have been considered by the Examiner and is attached to this Office Action.

*Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

5. Claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 13, 14, 15, 16, 17, 18, 19, 20, 21, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Hayward et al (Hayward) (U. S. 6,629,134).

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With respect to claims 1, 2, 3, 4, 5, 6, 8, 10, 12, 14, 15, 17, 18, and 21, Hayward discloses a method of suggesting printer upgrades based on actual usage (column 5, lines 41-57) comprising conveying a print job to a printer (column 3, lines 44-53); the printer including at least one functional characteristic (printing and ink levels) the print job requiring the utilization of the functional characteristics (consumable) (column 2, lines 25-40); assigning a numerical value (a threshold) to the degree of utilization of the consumable (column 2, lines 25-40) and maintaining the numerical value in a memory of the printer (column 2, lines 25-40); accessing information on a selection of upgrades available for the printer (column 5, lines 10-57, column 6, lines 42-50 and column 8, lines 38-58); comparing the information to the numerical value (the abstract, and column 8, lines 45-58), and suggesting the preferred upgrade to the user of the printer for installation on the printer (column 7, line 48 to column 8, line 23 and column 8, lines 45-58).

With respect to claims 7, 11, 19, and 20, Hayward discloses sending an e-mail to the user (column 8, lines 24-37).

With respect to claims 9 and 13, Hayward discloses downloading the information from a server attached to the Internet (column 3, lines 4-24 and column 5, lines 5-10).

With respect to claim 16, the upgrade comprises a software upgrade (column 3, lines 44-64).

With regard to claim 22, Hayward discloses a workstation (30) in communication with the printer (10) the workstation capable of conveying a print job to the printer (column 3, lines 44-64).

*Response to Arguments*

6. Applicant's arguments filed 3/22/2004 have been fully considered but they are not persuasive.

Applicant submits that Hayward does not disclose "conveying a print job to a printer said printer including at least one functional characteristic, said print job requiring the utilization of said at least one functional characteristic", "assigning a numerical value to the degree of utilization of said at least one functional characteristic", "maintaining said numerical value in a memory of said printer; accessing information on a selection of upgrades available for said printer", "comparing said information to said numerical value to select the preferred upgrade", and "suggesting said preferred upgrade to a user of said printer for installation on said printer". The Examiner disagrees.

Hayward discloses conveying a print job to a printer (column 8, lines 45-49), said printer including at least one functional characteristic (printing and ink levels), said print job requiring the utilization of said at least one functional characteristic (column 2, lines 25-40), assigning a numerical value (threshold value) to the degree of utilization of said at least one functional characteristic (column 2, lines 25-40), maintaining said numerical value in a memory of said printer (column 2, lines 25-40); accessing information on a selection of upgrades available for said printer (column 6, lines 1-4), comparing said information to said numerical value to select the preferred upgrade (column 5, lines 58-67), and suggesting said preferred upgrade to a user of said printer for installation on said printer (column 6, lines 1-57 and column 8, lines 38-66).

Applicant also submits that Hayward differs from claim 1 since claim 1 suggests printer upgrades of software for the printer based on actual usage of the printer. Applicant is arguing

subject matter not being claimed. Applicant cannot argue what is "suggested" by the claim, but what is actually being claimed. Nevertheless, Hayward discloses the upgrade comprises a software upgrade (column 3, lines 44-64).

### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

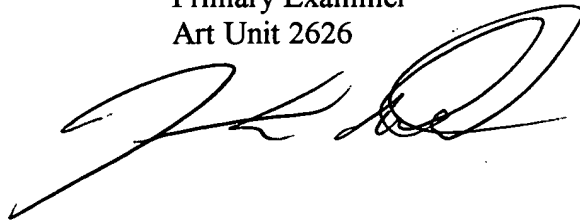
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark E. Wallerson whose telephone number is (703) 305-8581. The examiner can normally be reached on Monday-Friday - 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mark E. Wallerson  
Primary Examiner  
Art Unit 2626

A handwritten signature in black ink, appearing to read 'Mark E. Wallerson', is written over the printed name and title.